



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/480,724	01/07/2000	ROBERT CAREY	12640US01	4660

7590 10/08/2003

MCANDREWS HELD & MALLOY LTD  
500 WEST MADISON STREET  
34TH FLOOR  
CHICAGO, IL 60606

EXAMINER

DASS, HARISH T

ART UNIT PAPER NUMBER

3628

DATE MAILED: 10/08/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/480,724

Applicant(s)

CAREY ET AL.

Examiner

Harish T Dass

Art Unit

3628

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 23 July 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-41 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 20-41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.**

Re. Claim 20, First, the "claimed" invention recites that "one or more characteristics" of price appreciation is calculated for each of the available securities. That is to say, this step does NOT calculate the "price appreciation value", but rather one or more "characteristics" of the price appreciation. This is in direct conflict with the specification (pp. 4-5) that teaches calculating the "magnitude of the stock's [one-year and/or 6-month] price appreciation value" (i.e., calculating the "price appreciation value" for different time periods). This is NOT a "characteristic" of price appreciation. Rather, it is calculating the value of the different "types" of price appreciation. In another words, a one-year PAV and 6-month PAV are two distinct and separate values - they are not different "characteristics" of a common entity.

Second, the "claimed" invention recites that the ranking is performed according to "predetermined criteria". This "predetermined criteria", as recited, apparently is a predetermined relationship "between said one or more characteristics of price appreciation, said return-on-asset ratio and said price-to-cashflow ratio" in order to form a group of ranked securities. This is in direct conflict with the specification that teaches that separate rankings are performed for "each" category (i.e., [1] said one or more characteristics of price appreciation, [2] said return-on-asset ratio, [3] said price-to-cashflow ratio) (See Figure 1). There is NO predetermined relationship "between" these categories nor are these "predefined relationships" defined in the specification.

The invention as "disclosed" in the specification teaches a method of ranking available securities according to each performance criteria (i.e., PAV, return-on-asset ratio, price to-cashflow ratio). Once these three groups of securities are generated (i.e., grouped based on rankings of the securities according to each performance criteria), a final group is generated by choosing securities that rank a certain way in each group. The securities in the final group are then also ranked (i.e., sorted) to show the most desirable securities in a particular fashion.

This invention as "claimed" is NOT what was "disclosed" in the specification for the reasons stated above.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 40-41 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 40 and 41 are reciting a different class of invention than that of claim 20 from which they depend. That is, claim 40 is reciting an article of manufacture (i.e., a computer-readable medium) and claim 41 is reciting an apparatus (i.e., a computer). Claim 20 is a method claim. Consequently, neither claims 40 nor 41 recite any components of the claimed inventions. Therefore, it is vague and indefinite as to what the structures of the claimed article of manufacture or the apparatus are.

### ***Claim Objections***

3. Claims 40-41 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

A proper dependent claim shall not conceivably be infringed by anything which would not also infringe the basic claim. See MPEP § 608.01(n), Section III. However, the depending claims 40 and 41 recite " a computer-readable medium bearing a computer program containing instruction steps when installing said computer program in a general purpose computer, the computer performing the method of claim 20". Applying the

Art Unit: 3628

infringement test, what is needed to infringe claim 40 and 41 is, for example, a CD-ROM having computer executable code that if and when executed would cause a computer to do the calculating, ranking and selecting steps. However, such a CD-ROM would not infringe the method steps of claim 20 since the CD-ROM itself never performs any of the active steps of calculating, ranking, and selecting required by the method. In other words, mere possession of such a CD-ROM would infringe claims 40 and 41, but this is not enough to infringe claim 20. As a result, claims 40 and 41 are an improper dependent claims.

#### ***Response to Arguments***

4. Applicant's arguments with respect to claims 1-19 have been considered but are moot in view of the new ground(s) of rejection.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T Dass whose telephone number is 703-305-4694. The examiner can normally be reached on 8:00 AM to 4:50 PM.

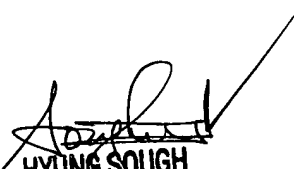
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-746-7238 for After Final communications.

Art Unit: 3628

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Harish T Dass *HTD*  
Examiner  
Art Unit 3628

7/14/03  
July 15, 2003

  
HYUNG SOUGH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600